

Inventor: Glen A. Evans  
Serial No.: 09/922,221  
Filed: August 2, 2001  
Page 2

**Regarding Priority**

The Office indicates at page 2, of the Action (Paper No. 9, mailed November 27, 2002) that priority to provisional application U.S. Serial No. 60/059,017, is not granted. Applicant respectfully submits that this application is a continuation-in-part of application Serial No. 09/554,929, filed in the United States on May 12, 2000, as a national stage application of International Application No. PCT/US98/19312, filed September 16, 1998, which claims the benefit of priority of provisional application Serial No. 60/059,017, filed September 16, 1997, now abandoned. As agreed to in the interview with Applicants' representatives on May 1, 2003, rather than denying priority with regard to all pending claims, Applicant will be afforded, if necessary, the opportunity to show support for any claimed subject matter in the priority document.

**Regarding 35 U.S.C. § 112, Second Paragraph**

As indicated in the Interview Summary (Exhibit A), the rejection of claim 13 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to distinctly claim and describe with particularity the subject matter regarded as the invention has been removed.

Inventor: Glen A. Evans  
Serial No.: 09/922,221  
Filed: August 2, 2001  
Page 3

Rejections under 35 U.S.C. § 102

Regarding WO 98/38296

As set forth in the Interview Summary (Exhibit A) the rejection of claims 1-11 and 14-17 under U.S.C. § 102(a), as allegedly anticipated by international patent publication WO 98/38296 has been removed.

Regarding Beattie et al.

As indicated in the attached Interview Summary (Exhibit A), this rejection has been removed with regard to claims 9-23.

Applicant respectfully traverses the rejection of claims 1-11 and 14-18 under U.S.C. § 102(b), as allegedly anticipated by Beattie et al., Biotechnology and Applied Biochemistry 10:510-521 (1988).

For the reasons that were discussed during the interview and as summarized below, Applicant submits that the cited reference by Beattie et al. does not contain all of the elements of Applicant's claimed invention of claims 1-11 and 14-18 and, therefore, does not anticipate the invention defined by these claims.

Applicant's invention of claims 1-11 and 14-18 is directed to a method of polynucleotide assembly that incorporates

Inventor: Glen A. Evans  
Serial No.: 09/922,221  
Filed: August 2, 2001  
Page 4

the element of sequentially adding a next most terminal double-stranded oligonucleotide. As discussed during the May 1, 2003, interview, in particular, Applicant disagrees with the attention that Figures 6 and 8, and pages 514-518, of the Beattie et al. reference describe the sequential addition of a next most terminal double-stranded oligonucleotide. During the May 1, 2003, interview Applicants' representatives reviewed with the Examiner each of the cited passages of Beattie et al. and pointed out the absence of any description of sequential addition of a next most terminal double-stranded oligonucleotide. As indicated in the Interview Summary (Exhibit A), the Examiner has indicated that this argument for removal based on lack of anticipatory will be considered favorably.

In view of the above, Applicants now respectfully request removal of the rejection of claims 1-11 and 14-18 under 35 U.S.C. §102(b) over Beattie et al., which does not describe the addition of a next most terminal double-stranded oligonucleotide.

#### Rejections under 35 U.S.C. § 103

The rejection of claims 12 and 13 under 35 U.S.C. §103(a) as allegedly rendered obvious by Beattie et al., *supra*, in view of Wallis et al., United States Patent No. 6,287,807, respectfully is traversed.

The rejection of claim 22 under 35 U.S.C. §103(a) as allegedly rendered obvious by Beattie et al., *supra*, in view of

Inventor: Glen A. Evans  
Serial No.: 09/922,221  
Filed: August 2, 2001  
Page 5

Wagner, United States Patent No. 6,120,992, respectfully is traversed.

As agreed upon during the May 1, 2003, interview, the instant rejections under §103(a) relies on the Beattie et al. reference, which provides primary support for the rejections. In this regard, the Examiner has indicated, as reflected in the Interview Summary (Exhibit A), that this rejection will be removed if the 102(b) rejection over the same reference is removed.

For the reasons set forth above and discussed during the May 1, 2003, interview, the cited patent by Beattie et al., alone or in combination with any of the cited secondary references, does not describe all elements of the method of any of claims 12, 13 and 22. In particular, Beattie et al. does not provide the method of Applicant's base claims to any combination that is alleged to yield Applicant's claimed invention of claim 12, 13 and 22 and cannot be relied on for provision of these elements to support the present rejections under 35 U.S.C. §103(a).

Accordingly, Applicant requests removal of the distinct rejections of claims 12-13 and 22, under 35 U.S.C. §103(a) over Beattie et al., *supra*, in view of in view of Wallis et al., United States Patent No. 6,287,807, as applied to claims 12 and 13; and, separately, in view of Wagner, United States Patent No. 6,120,992, as applied to claim 22.

Inventor: Glen A. Evans  
Serial No.: 09/922,221  
Filed: August 2, 2001  
Page 6

CONCLUSION

In light of the above remarks and the arguments set forth during the interview conducted on May 1, 2003, Applicant submits that the claims are in condition for allowance and respectfully requests a notice to this effect. The Examiner is invited to contact the undersigned attorney or Cathryn Campbell with any questions in regard to this application.

Respectfully submitted,

May 27, 2003  
Date

Astrid R. Spain  
Astrid R. Spain  
Registration No. 47,956  
Telephone No. (858) 535-9001  
Facsimile No. (858) 535-8949

McDERMOTT, WILL & EMERY  
4370 La Jolla Village Drive  
7<sup>th</sup> Floor  
San Diego, California 92122